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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/673,642	06/25/96	ROSE	M 6253

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B5M1/1202

EXAMINER

LE, T

ART UNIT	PAPER NUMBER
2514	

RECEIVED

DATE MAILED

12/02/97

DEC - 8, 1997

LAW DEPARTMENT

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

dc
WC
Response due March 2, 1998.

Office Action Summary

Application No.
08/673,642

Applicant(s)

Rose

Examiner

Thien Le

Group Art Unit

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☒ Responsive to communication(s) filed on Sep 8, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 3-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 6 and 7 is/are allowed.

☒ Claim(s) 1, 3-5, and 8-11 is/are rejected.

☒ Claim(s) 12-18 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

1. The amendment filed on 9/8/97 has been entered. Claims 1 and 3-18 are presented for examination.

The information disclosure statement filed on 9/23/96 has been entered. Claims 1-10 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5, drawn to the apparatus and method claim 8-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Barakai et al. [referred to as Barakai - 5,103,079] in view of Vak et al. [5,473,143 - newly cited].

Regarding claim 1, Barakai discloses a portable terminal 10 comprising a key pad 20 which contains between 10-15 keys [Fig. 1], a card reader 12 [Fig. 1], a modem 50 [Fig. 1] which is connected to a telephone channel, a display 22 [Fig. 1], a logic means 24 [Fig. 1] which is used to accept data from the card reader and the keypad for transmitting to a base station 40 [see Fig. 1]. The claim differs in calling for a wireless modem. It would have been obvious to replace

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Barakai's modem with a wireless modem. This is because an ordinary skilled artisan is well aware of the use and the benefits of using a wireless modem in portable transaction devices. Commercially available devices such as cordless telephones, electronic note pads, POS terminals, card readers having wireless modem for data communication are known and old. Without any unexpected result, the modification is merely a substitution of an art recognized equivalent which would have been plainly obvious to an ordinary skilled individual in the art. Reference to Vak et al. is cited as an evidence showing the interchangeability of wired and wireless modems [see col. 7, lines 5-20]. Further it would have been obvious to incorporate a printer in Barakai's system. The modification allows the system to printout receipts for the transactions which are helpful for record keeping purposes. An ordinary skilled artisan would have been aware of the use of the printer for printing receipts in transaction devices such as Barakai's system and would have been motivated for making the modification to allow record keeping.

Regarding claim 2, Barakai is silent about the means and steps of issuing messages to instruct a user to insert a card and enter a monetary amount. However, it would have been obvious to incorporate such means and steps in the processing unit as taught by Barakai. Noticed that conventional and commercially available credit transaction system include at least some or all of the following steps:

- Choosing type of transactions [credit, debit, ATM, etc.]
- *Card reader displays a message requesting user to present a card to the reader slot*
- User present the card to the reader
- *Card reader request for a transaction amount on the display*
- User input the transaction amount to the card reader

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- Confirmation [optional]
- Transmitting data to a host computer or a local database for verification

Since an ordinary skilled artisan is well aware of the use of such user friendliness instructions, means and procedures in a typical credit card reader and transaction system such as Barakai's system, the modification is merely a design consideration which is not considered novel.

Claim 3 differs in calling for a means to transmit a terminal identification code. Although Barakai is silent about this feature, it would have been obvious to incorporate such means for transmitting the terminal identification code in the processing unit as taught by Barakai's system. The modification allows the host system to keep track of which terminal a transaction is being conducted. This feature is necessary in a network environment in which a plurality of card readers are needed such as whole sale markets, groceries stores, etc. Since an ordinary skilled artisan is well aware of the use of a terminal transaction code in typical credit transaction system and the fact that such network environment is a plainly obvious application of Barakai's system, the modification is merely a design consideration which is not considered novel.

Regarding claim 4, Barakai's terminal includes a wireless modem [see the discussions regarding claim 1] which receives ACK or verification from the remote host/base station 40. The claim differs in calling for a light means indicating status of the receipt signal. However, this claimed feature is not new. The use of ACK or verification indicators are known and old in credit transaction systems and devices. Examples are commercially available readers, scanners, etc., that could be found in shopping centers, grocery stores, etc. Without any unexpected result,

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it would have been obvious to incorporate a light means to indicate receipt of a verification or ACK signal from the base station 40. The modification is merely a design consideration which is added to increase user friendliness feature; and thus is not considered novel. Regarding the claimed feature that the light could be visible for at least 20 feet, this claimed feature is clearly subjective. In addition, most [if not all] indicators used in portable devices as scanners, readers, etc., would have met this claimed feature. For this reason, it would have been plainly obvious to incorporate a light means having such claimed distance illumination characteristics in Barakai's system.

Regarding claim 5, see the discussions above regarding claims 1-2. The claim differs in calling for plurality of terminals and base stations. It would have been obvious to incorporate such limitations in Barakai's system. This is because the modification is merely a method of providing multiple terminals and base stations of Barakai in a close environment such as a whole sale store, a grocery store, etc, in which multi-lanes transaction system is used. Without any unexpected result, the modification is considered as an obvious application of Barakai's system which is not considered novel.

Regarding claim 8, see the discussions regarding claims 1-2 above.

Regarding claim 9, see the discussions regarding claim 1-2 and 4 above. Specifically, the phrase reciting a person who is not familiar with the system is clearly subjective which does not add any limitations to the discussions set forth in claim 2 regarding the transaction instructions.

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Regarding claim 10, the claimed means would be met by the means which generates instructions to instruct a user to present a card and enter an amount as set forth regarding claim 2.

Regarding claim 11, the data card which is workable with Barakai's system would have met all limitations set forth in this claim.

Allowable Subject Matter

4. Claims 6-7 are allowed.

5. Claims 12-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is an examiner's statement of reasons for allowance: The prior art fails to disclose a transaction unit having the means for preventing one from changing the entered transaction [billing] amount in the manner as recited in claim 6. The prior art also fails to disclose the claimed method of disabling the wireless modem, the alternate messages, etc. as recited in claims 12-18.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. Applicant's arguments filed on 9/8/97 has been entered but are not considered persuasive. Applicant argued that none of the cited references includes a wireless modem, and that Barakai's system does not work with a wireless modem. Applicant further discussed the differences between wireless and wired modems. The examiner respectfully disagrees with these arguments. First, wireless and wired modem have been known and used in most data communication systems for transferring data. Due to their daily used in data communication devices, using a wireless modem in place of a wired modem would have been plainly obvious to an ordinary skilled artisan. Applicant is correct in pointing out that placing a wireless modem in Barakai's system would also require replacement of the modem on other devices communicating with Barakai's system. The examiner agrees. However, once the artisan decides to use wireless technology, he/she would have been well aware of the incorporation of the wireless modems such that they would render the system operative. The examiner strongly disagree with applicant's piecemeal analysis of the difference between wireless and wired modems. Although they are different in design and utilizing different data transferring methods, they have been used in the art as alternative design choices. A simple APS query search for "wireless (5a) modems" would give at least hundreds of hits. Most of these references would include a sentence or two discussing the use wireless

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modems as alternative for wired modems. Reference to Vak et al. is cited as an evidence showing this concept. Further, an ordinary skilled artisan would have been well aware of the tradeoffs of using wired and wireless modems in terms of data security, signal fidelity, portability, etc. It is also noted that none of the claims requires that the modem must be work via telephone line in the manner as shown in Fig. 1. For these reasons, applicant's arguments are not considered persuasive. The examiner further cites more references showing the interchangeability of wired and wireless modems. Regarding claim 3, Barakai shows a local-central type of connection. Although Barakai does not specifically show a network type arrangement, it makes very little sense that each central computer can only work with a local terminal. The use of multiple local POSs to a central computer have been implemented in virtually all banking and credit transaction systems - all of which are commercially available for our daily usage. The examiner firmly asserts that the modification and motivation as discussed in claim 3 would be sufficient to establish a prima case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien Le whose telephone number is (703) 305-3500. The examiner can normally be reached on Monday to Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald T. Hajec, can be reached on (703) 308-4075. The fax phone number for this Group is (703) 308-7723.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [don.hajec@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Thien Le
Art Unit 2514
October 27, 1997